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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,727	01/22/2001	Paul Foster	21300.105003	1307
20786	7590	02/09/2005	EXAMINER	
KING & SPALDING LLP 191 PEACHTREE STREET, N.E. ATLANTA, GA 30303-1763			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/766,727

Applicant(s)

FOSTER ET AL.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02062005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The replacement oath/declaration that includes the application number of the provisional application, which was submitted on January 22, 2001 and with the preliminary amendment submitted on June 4, 2001, is missing the inventor's signature.

### **Affidavit**

The affidavit filed on June 25, 2001 has been considered.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 339, 4a99, 4b99, and 4c99. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by

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the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The abstract of the disclosure is objected to because:

The use of the phrase "such as" is improper; "data base" should be "database"; and there is a spacing issue between "databases" and "Building". Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

On p.2, first paragraph, "data base" should be "database", and "provides" should be "provide".

On p.4, third paragraph, "available" should be "availability".

On p.6, "data base" should be "database", and "110-115" should be "110 and 115".

On p.10, second paragraph, "breakeven" should be "break-even".

On p.16, last paragraph, there is spacing issue between "for" and "space".

On p.17, third paragraph, there is a spacing issue between "questions" and "The".

On p.18, first paragraph, there is spacing issue between "embodiment 1" and "These", and in the second paragraph, there is a spacing issue between "criteria" and "In".

On p.19, second paragraph, "40c05" should be "4c05", and there should be a comma after "transaction cost schedule" instead of a period.

On page 23, there is a spacing issue between claims 5 and 6. The claims should fill the entire page and then the next page.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 and 13-14 are rejected for the following reasons:

In claims 1 and 2, "selected real estate property" lacks antecedent basis.

In claim 13, "offers" lacks antecedent basis.

Appropriate correction is required.

The remaining claims are rejected for their dependency upon rejected claims.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

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Claims 6-14 are rejected under 35 U.S.C. 101, because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following is suggested:

In the body of the claim include structural / functional interrelationship which can only be computer implemented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenlee (US 2001/0037273).

Greenlee discloses a method and corresponding system for commercial real estate automation comprising a distributed computer network comprising a property management services server, databases and client computers, each coupled to a computer network (fig.1 and p.3, 37); the property management services server hosting a leasing program module for completing a lease for real property (fig.1 and p.3, 37-38); the databases storing real estate property-related data, including property comparables data for multiple real estate properties (p.3, 37-38); the client computers operable by users to access the leasing program module operating on the property management services server and to input the selected real estate property in support of predetermined information about completing a lease for the selected real estate property (fig.1 and p.3, 37-38); wherein, responsive to the predetermined information about the selected real estate property, the leasing module program operating on the property management services server accesses the property data in at least one of the databases via the computer network to obtain comparables relevant to the selected real estate property, completes the lease for the selected real estate property, and presents the lease and the comparables for the selected real estate property (fig.1; p.3, 37-39; and p.4, 42-43); plurality of users selected from the group, comprising a tenant evaluating the selected real estate property for a potential lease, a lender for supporting property financing requirements for the selected real estate property, a site visit agent for supporting on-site property review and analysis of the selected real estate property, property specialist for providing property-related expertise in connection with the selected real estate property, and a deal agent for screening, negotiating, and closing

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property-related transactions (p.3, 37-38); the property specialist comprises property appraisal specialists, property engineering specialists, and property environmental specialists (p.3, 37-40 and p.4, 42-43—may be any user); program modules for budgeting, financing, and forecasting of property payments for real estate property (p.7, 72-75); the databases are databases containing property information maintained at a local site or databases containing property information maintained at a remote site (fig. 1 and p.3, 37-38); storing owner property characteristics on-line, defining a tenant's property requirements on-line, conducting a search on-line to locate owner properties matching the tenant's property requirements, and publishing on-line the owner properties that match the tenant's property requirements (p.5, 51 to p.6, 61); modifying on-line the tenant's property requirements (p.5, 52-53 and p.5, 59 to p.6, 60); ordering on-line supplemental information for the owner properties that match the tenant's property requirements (p.6, 62-64); ordering on-line an inspection of the owner property matching the tenant's property requirements, coordinating on-line the inspection by a state representative, and generating on-line a term sheet for the inspection (p.6, 60-- may be done during the inspection using the database); creating a lease agreement on-line by populating the owner's property characteristics with lease terms and legal provisions, publishing the lease agreement on-line for review by interested parties, allowing the interested parties to revise the lease agreement on-line, and allowing the interested parties to execute the lease agreement on-line (p.5, 51 to p.6, 61); allowing interested parties to make offers on property on-line, allowing the interested parties to accept the offers on-line, and allowing the interested parties to modify the offers on-line



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(p.5, 51 to p.6, 61); entering property information, making help information available regarding entering property information, conducting a search based on the property information, and displaying search reports (p.5, 51 to p.6, 61); scheduling a property inspection on-line, registering a user, allowing a user to log in, running a property cost analysis on-line, searching property listings on-line, selecting a property on-line, entering property location and owner address information on-line, entering property business terms on-line, sending and receiving offers on-line, sorting the offers on-line, accepting or modifying the offers on-line, completing an offer analysis on-line, and generating an offer analysis report on-line (p.5, 51 to p.6, 65); and forming a lease on-line, making changes to the lease on-line, executing the lease with a digital signature on-line, scheduling lease transaction costs on-line, sending lease bills on-line, making lease payments on-line, and managing the lease on-line (p.5, 51 to p.6, 65).

#### **Provisional Application Listed on PTO-892 form**

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can

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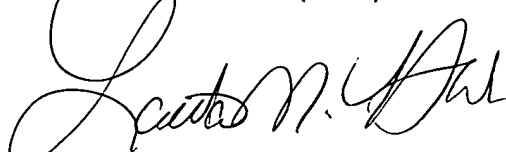
demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH